Paper No. 9
SIMMS/md

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 10 ,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Moore U.S.A., Inc.

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Serial No. 75/331,521

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Robert A. Vanderhye of Nixon & Vanderhye P.C. for Moore U.S.A., Inc.

Susan J. Kastriner, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney)

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Before Simms, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Moore U.S.A., Inc. (applicant) has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below

for blank and preprinted repositional and removable labels.[1] The Examining Attorney has refused registration under Section 2(d) the Act, 15 USC §1052(d), on the basis of Registration No. 1,787,491, issued August 10, 1993, for the mark LIFT-OFF for adhesive application tape used for transferring vinyl letters and logos. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

In this case, the Examining Attorney argues that the respective marks are similar in sound, appearance and connotation, with both marks bringing to mind the concept of "lifting off." The Examining Attorney argues that more weight should be given to the literal portion of applicant's mark, which is nearly identical to the registered mark. According to the Examining Attorney, the word portion is more likely to be impressed upon a purchaser's memory and be used in calling for applicant's goods. The Examining Attorney also argues that we must view the issue of likelihood of confusion in terms of the recollection of the average purchaser, who retains a

[1] Application Serial No. 75/331,521, filed July 28, 1997, based upon application's allegations of use and use in commerce since July 1995.

general rather than a specific impression of a trademark. The Examining Attorney does not believe that the design element in applicant's mark is sufficient to avoid likelihood of confusion.

With respect to the goods, the Examining Attorney notes that applicant's specimens show that applicant's goods may be used to label books, boxes, cassettes and diskettes. The Examining Attorney argues that registrant's adhesive application tape may be used for a similar purpose. Accordingly, the Examining Attorney argues that the respective goods are highly related and likely to be sold in the same types of stores to the same class of purchasers. Although applicant's goods may be placed on objects and removed while registrant's goods may be used to remove and reposition other labels, the Examining Attorney contends that these goods are nevertheless highly related. The Examining Attorney has made of record electronic copies of third-party registrations showing that the same mark has been registered to a particular entity both for labels and for adhesive tape. With respect to applicant's evidence concerning the lack of instances of actual confusion (discussed below), the Examining Attorney argues that applicant's mark has only been used for about three years and that this factor is entitled to relatively little

weight in this case. The Examining Attorney also argues that doubt must be resolved in favor of the prior user and registrant.

Applicant, on the other hand, argues variously that the rocket ship design element of applicant's mark "dominates" or "pervades" applicant's mark or is at least "co-equal with" the literal portion of its mark. Applicant argues that this design is highly distinctive and recognizable. Also, applicant contends that the registered mark is suggestive and weak and that no one has the exclusive right to use the words "LIFT OFF" for Class 18 goods. Response, filed April 13, 1998, 6. Applicant's attorney points to third-party registrations containing the term "LIFTOFF" for bakery pan liners and computer programs. Applicant also argues that the connotation of the respective marks as applied to the respective goods is different, with applicant's mark suggesting that applicant's goods lift off from a surface whereas registrant's mark suggests that registrant's goods are used to lift off other products.

Further, applicant contends that its goods are ordered by someone inspecting an office catalog or a brochure and are not ordered by word-of-mouth. Thus, applicant argues

that the design of its mark is more significant than the Examining Attorney would have it.

It is also applicant's position that the goods of applicant and registrant travel in different channels of trade. Counsel states that, as far as he is aware, the specialty adhesive tape listed in the registration is not shown in the same office product catalogs as applicant's removable labels. In this regard, applicant's attorney argues that, while conventional adhesive tape is sold in the same channels of trade as applicant's goods, registrant's specialty tape, used as a tool to transfer letters or logos, is not.

Applicant also has submitted the declaration of the director of sales and marketing of a division who attests to the fact that there have been no instances of actual confusion despite nearly three years of use of applicant's mark.

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that confusion is likely. Here, the respective marks are identical in pronunciation and are otherwise very similar. While we have considered applicant's arguments concerning the different connotations of the marks, we do not believe that these differences would be apparent to the

average purchaser of these relatively inexpensive goods. Even if they were, we do not believe that those subtle distinctions would avoid the likelihood of confusion. Nor would the design element. Furthermore, in view of the lack of restrictions in the respective identifications, we believe that registrant's adhesive tape used for transferring letters and logos and applicant's removable labels are likely to be sold in the same types of stores (for example, office supply stores) to the same class of ordinary purchasers. These goods are highly related. And, of course, in order for confusion to be likely, the respective goods need not be identical. They need only be related in such a manner or conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from the same source. A purchaser aware of registrant's LIFT-OFF adhesive tape used for transferring letters and logos who then encounters applicant's LIFT OFF and design removable labels is likely to believe that these goods, albeit slightly different, emanate from the same source.

Decision: The refusal of registration is affirmed.

R. L. Simms

D. E. Bucher

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial and
Appeal Board